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EXAMINER

COLBERT, E

ART UNIT	PAPER NUMBER
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2771

*16*

DATE MAILED:

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

*BGS*

<b>Office Action Summary</b>	Application No. <b>08/863,047</b>	Applicant(s) <b>Fumiaki et al</b>
	Examiner <b>Ella Colbert</b>	Group Art Unit <b>2771</b>

Responsive to communication(s) filed on Jul 3, 2000.

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1, 3-5, and 8-61 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1, 3-5, and 8-61 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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***Response to Amendment***

1. Claims 1, 3-5 and 8-61 are presented for examination.
2. The prior Office Action is included by reference.
3. Those applicable sections of Title 35 of United States Code not presented herein were presented in an earlier Office Action.
4. Applicant's response of 03 July 2000 to the Office Action has been entered as Amendment C, paper number 15.
5. Applicant's arguments with respect to claims 1, 3-5, and 8-61 have been fully considered but are not convincing.

***Response to Arguments***

6. In Applicant's Response, Applicants' argue: on page : a) "assuming *arguendo* that the recited columns and lines in *Morita* somehow do teach some type of notification method, there is absolutely no mention *anywhere* in *Morita* of an **advance** notification means as recited in amended claim 1;" and b) "*Hill* neither teaches nor suggests the advance notification feature of amended Claim 4, by means of which an operator can determine which folder to store a document as a result of the notification."
7. As to a) and b) above, in this rejection of claim 1 and others, for example, under Section 102 Title 35 of the United States Code, the Examiner carefully drew up a correspondence between each of Applicants' claimed limitations in *Morita* et al and *Hill* et al. The Examiner is

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entitled to give claims their broadest reasonable interpretation in light of the Specification (see below):

2111           Claim Interpretation; Broadest Reasonable Interpretation [R-1]

>CLAIMS MUST BE GIVEN THEIR BROADEST REASONABLE INTERPRETATION

*During patent examination, the pending claims must be “given the broadest reasonable interpretation consistent with the specification.” Applicant always has the opportunity to amend the claims during prosecution and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. In re Prater, 162 USPQ 541,550-51 (CCPA 1969) (Claim 9 was directed to a process of analyzing data generated by mass spectrographic analysis of a gas. The process comprised selecting the data to be analyzed by subjecting the data to a mathematical manipulation. The examiner made rejections under 35 U.S.C. 101 and 102. In the section 102 rejection, the examiner explained that the claim was anticipated by a mental process augmented by pencil and paper markings. The court agreed that the claim was not limited to using a machine to carry out the process since the claim did not explicitly set forth the machine. The court explained that “(reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from ‘reading limitations of the specification into a claim,’ to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. “The court found that applicant was advocating the latter, e.g., the impermissible importation of subject matter from the specification into the claim.).<*

In this instance, Morita’s notification means is interpreted by the Examiner as being the description of the folder in an order indicating (notifying means or method) the number of documents related to the keywords is larger in order of the description in column 12, lines 38-41 column 14, lines 50-67. As to b) above, the Examiner does not find the Applicants’ amended

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claim feature “advance notification” according to the Applicants’ claimed invention in the Specification because Applicants’ have made an unsubstantiated allegation and offered no evidence or veracities to support their “advance notification.” Furthermore, Applicants’ Specification renders no definition of “advance notification.”

For this reason, the rejections from the prior Office Action are maintained including 112 rejections and repeated below:

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

*The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.*

The amendment filed is objected to under 35 U.S.C. 132 because it introduces new matter into the Specification. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicants’ Specification does not teach nor mention “advance notification.” Lack of support in the Specification does not allow the Examiner to understand what the Applicants’ mean by “advance notification.”

Applicants’ are required to cancel the new matter or to cite the page and line numbers where the considered new matter is found in the reply to this Office action.

***Claim Rejections - 35 USC § 112***

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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*The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.*

10. Claims 1, 4, 5, and 9-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants' claims show a lack of support in the Specification of the claimed subject matter in claim 1, lines 10 and 11, "advance notification." In claims 4, 5, and 9-14, Applicants' again show a lack of support in the Specification for " advance notification."

***Claim Rejections - 35 USC § 102***

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

12. Claims 1, 3, 5, 8-34 and 39-61 are rejected under 35 U.S.C. 102(e) as being anticipated by Morita et al (US 5,832,470), hereafter Morita.

With respect to claim 1, 9, and 12, a document retaining means for retaining folders storing at least one document (**column 2, lines 66-67 and column 3, lines 1-10**), a candidate folder selecting means for selecting a candidate folder suitable for retaining a new document by comparing a feature of a new document with an average of features of the documents ... among

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the folders (**column 3, lines 48-57, column 6, lines 50-56 and column 11, lines 1-17**) and a notifying means providing advance notification of a candidate folder selected by a candidate folder selecting means (**column 12, lines 27-44 and column 14, lines 50-67**).

With respect to claims 3, 15, and 16, candidate folders suitable for saving a new document are selected and a list of selected candidate folders is displayed (**column 16, lines 29-52**).

With respect to claims 5, 11, and 14, a retaining means for retaining folders storing sets of documents (**column 3, lines 20-32**), a selecting means for selecting a folder from among the folders based on a number of sets of document information containing a keyword input as a search condition (**column 25, lines 27-35 and lines 63-67 and column 26, lines 1-9**) and a notifying means for providing advance notification of the folder selected by a folder determining means (**column 29, lines 57-67 and column 30, lines 1-3 and lines 60-67**).

With respect to claim 8, the selecting means selects the folder through statistical estimation using the number of information sets of documents belonging to the folder and the number of documents matching the search condition (**column 11, lines 53-57 and column 24, lines 36-57**).

With respect to claims 9 and 12, retaining folders storing at least one document (**column 2, lines 66-67**), selecting a candidate folder for retaining a new document by comparing a feature of the new document with an average of features of the documents in a folder among the folders (**column 3, lines 48-57 and column 6, lines 50-56**) and providing advance notification of the candidate folder selected in a selecting step (**column 12, lines 27-44**).

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With respect to claims 10 and 13, judging a similarity degree between document information and sets of information of documents stored in a folder (**column 1, lines 38-67, column 6, lines 57-67 and column 7, lines 1-8**), calculating a similarity order of the folders in accordance with the similarity judged in the judging step (**column 13, lines 5-18, column 25, lines 63-67 and column 26, lines 1-9**) and providing advance notification of the similarity order of the folders calculated in the calculating step (**column 26, lines 10-38 and column 27, lines 2-24**).

With respect to claims 17, 23, 29, and 43, a means for updating the feature of the folder in response to saving the new document in the candidate folder (**column 14, lines 5-10**).

With respect to claims 18, 24, and 30, the document includes vector data (**column 11, lines 20-36**).

With respect to claims 19, 25, and 31, the candidate folder has a high-level rank determined by the result of the comparison (**column 12, lines 45-64**).

With respect to claims 20, 26, and 32, the notifying means displays a label set in advance to indicating the candidate folder (**column 25, lines 19-35**).

With respect to claims 21, 27, 33, 42, 46, 50, 55, and 60, the document includes text data (**column 25, lines 40-62**).

With respect to claims 22, 28, and 34, means for causing the selected candidate folder to save the new document (**column 26, lines 10-38**).

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With respect to claim 39, notification is provided of a predetermined number of folders having a high rank of similarity order (**column 18, lines 48-67 and column 19, lines 1-30**).

With respect to claim 40, the document is stored in at least one folder mentioned in the notification provided in the notifying step (**column 2, lines 66-67 and column 3, lines 1-19**).

With respect to claims 41, 45, 47, 52, and 57, displaying a label set in advance to the selected folder (**column 25, lines 19-35**).

With respect to claim 44, the document is stored in at least one folder mentioned in the notification provided in said notifying step (**column 6, lines 50-56 and column 8, lines 42-56**).

With respect to claims 48, 53, and 58, the selected folder contains a predetermined number of folders which are highly ranked in number (**column 16, lines 53-67 and column 17, lines 1-4**).

With respect to claims 49, 54, and 59, the selecting means selects folders which are highly ranked in including the keyword" (**column 20, lines 40-62**).

With respect to claims 51, 56, and 61, a control means for causing the selected folder to store the document information (**column 21, lines 19-30**).

*Claim Rejections - 35 U.S.C. § 102*

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

14. Claims 4 and 35-38 are rejected under 35 U.S.C. 102(e) as being anticipated by Hill et al (US 5,745893), hereafter Hill.

With respect to claim 4, a judging means for judging a similarity degree between document information and sets of information of documents stored in a folder (**column 1, lines 33-41 and column 2, lines 25-38**), a similarity order calculating means for calculating a similarity order of folders according to the similarity judged by the judging means (**column 1, lines 42-67 and column 2, 39-48**) and a notifying means for providing advance notification of the similarity order of folders calculated by the similarity order calculating means (**column 3, lines 1-38**).

With respect to claim 35, the notifying means provides notification only of a predetermined number of folders with a high rank of similarity order (**column 6, lines 24-38**).

With respect to claim 36, the document stored in at least one folder mentioned in the notification provided by the notifying means (**column 6, lines 60-67 and column 7, lines 1-16**).

With respect to claim 37, the notifying means displays a label set in advance to the selected folder (**column 2, lines 49-67 and column 4, lines 3-39**).

With respect to claim 38, the document includes text data (**column 4, lines 41-61**).

### *Conclusion*

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Driscoll (5,642,502) disclosed searching for relevant documents using statistical ranking.

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Turtle et al (5,488,725) disclosed document retrieval by successive iterated probability sampling.

Gallant (5,317,507) disclosed document storage by combining the context vectors of the words.

Hill et al (5,745,893) disclosed a symmetric matrix with a relevance value representing a relevance between each document .

Lewak (5,544,360) disclosed organization of data into files and directories (file folders and hanging files).

Caid et al (5,619,709) disclosed context vector generation and retrieval.

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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### INQUIRIES

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ms. Ella Colbert whose telephone number is (703) 308-7064. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m. EST. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Kim Vu, can be reached on (703)305-4393.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703)308-9051, (for formal communications intended for entry).

**Or:**

(703)308-5403 (for informal or draft communications, please label  
“PROPOSED” or “DRAFT”).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Virginia., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703)308-9600.

Colbert

September 8, 2000



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